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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Yang, *et al.*

Serial No.: 10/586,765

Case No.: 21556YP

Art Unit:

1625

Filed: July 20, 2006

Examiner:

Rahmani, N.

For: 2, 6-DISUBSTITUTED PIPERIDINES AS MODULATORS
OF CHEMOKINE RECEPTOR ACTIVITY

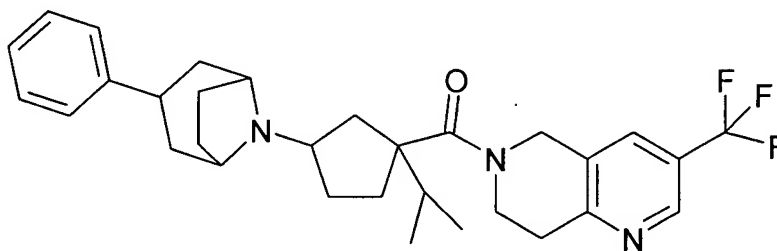
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION / ELECTION REQUIREMENT

Sir:

This paper is responsive to the Office Action mailed July 6, 2007.

Applicants are required to elect a single invention, and a single chemical species, for examination. Subject to the traversal contained in the remarks provided below, Applicants provisionally elect the invention of Group II, drawn to compounds of formula I, wherein X is carbon and Y is nitrogen; and elect the species identified in Example 1, namely, 6-{{[1-isopropyl-3-(3-phenyl-8-azabicyclo[3.2.1]oct-8-yl)cyclopentyl]carbonyl}-3-(trifluoromethyl)-5,6,7,8-tetrahydro-1,6-naphthyridine:



This Restriction Requirement is traversed because it is believed that examination of all claims wherein X is carbon or nitrogen and wherein Y is carbon or nitrogen would not represent a serious burden to the Examiner. A complete examination of all claims wherein X is carbon or nitrogen, and wherein Y is carbon or nitrogen, would require the Examiner to review many of the very same references that would be reviewed in connection with the examination of Group II. Applicants further note that an examination of claimed structures wherein X is carbon or nitrogen, and wherein Y is carbon or nitrogen, is appropriate here since the resulting alternate structures share a significant common structure, and share the common property of modulating chemokine receptor activity.

Moreover, the Examiner has provided no justification for the exclusion from Group II of claim 32 directed to pharmaceutical compositions, or claims 33-35 directed to methods of using the claimed compounds to modulate chemokine receptor activity, and treating diseases by modulating chemokine receptor activity. Clearly, compounds capable of modulating chemokine receptor activity share a common inventive concept with pharmaceutical compositions and treatment methods employing these very same compounds for the purpose of modulating chemokine receptor activity. As noted by the Examiner, Annex B Part 1(e) specifically contemplates that compound claims (i.e., claims to a "product") and method of use claims (i.e., claims "for the use of said product") may comprise a single invention. Applicants therefore see no justification for excluding claims 32-35 from examination. If the Examiner maintains that claims 32-35 cannot be examined in connection with Group II, applicants respectfully request a detailed explanation justifying this position (and not simply a recitation of Rules, as was contained in the July 6, 2007 paper).

If there are any issues outstanding after consideration of this paper, the Examiner is invited to contact the undersigned to expedite prosecution of this case.

Attorney for Applicants can be reached at the telephone number and address below. Correspondence should continue to be sent to the address below. Although no fees are believed to be due, any fees occasioned by this paper or any fee overpayments should be charged or credited to Deposit Account **13-2755**.

Serial No.: 10/586,765
Case No.: 21556YP
Page 3

Respectfully submitted,

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Date: July 31, 2007

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

MERCK & CO. INC.

E. A. Reynolds Date 7-31-07